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09/696,458	10/25/2000	Douglas M. Jennings	1712-0001	3571

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Paul J. Maginot, Esq.
Maginot, Addison & Moore
Bank One Center/Tower
111 Monument Circle, Suite 3000
Indianapolis, IN 46204-5130

EXAMINER

LUM VANNUCCI, LEE SIN YEE

ART UNIT PAPER NUMBER

3611

DATE MAILED: 07/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 25

Application Number: 09/696,458
Filing Date: October 25, 2000
Appellant(s): JENNINGS, DOUGLAS M.

MAILED

JUL 27 2004

GROUP 3600

Paul Maginot
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/27/04.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

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(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 26-44 and 52-61 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

Supplemental product flyer distributed by "Auto Meter Products, Inc.", providing "gauge bezels" for various vehicle models, and "New for '99", and "Available in June!"

10) *Grounds of Rejection*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 26-44 and 52-61 are rejected under 35 U.S.C. 102(a) as being anticipated by a supplemental product flyer distributed by "Auto Meter Products, Inc.", printed before June 1999 (as evidenced by the title "New for '99", and statement in center of page, "Available in June!").

Re **Claims 26-44**, Auto Meter discloses a replacement instrument bezel comprising bezel (body of this product) configured to be mounted in a bezel-mounting space defined between a dashboard housing (inherent) and an instrument assembly (unidentified), the latter including a window (inherent) and speedometer (meter towards center of assembly),

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the original bezel possessing no instrument mounts (i.e., OEM),
one or two instruments secured* to the bezel in respective instrument mounts, each on opposite sides of the lower portion of the bezel.

* It is clear that the additional instrument may be installed before or after the replacement bezel is installed, depending on the type of instrument. This feature does not affect the function of the invention.

Re **Claims 52-61**, Auto Meter discloses a method of adding an instrument to a vehicle that includes a speedometer, the obvious steps comprising
removing an original part (instrument bezel) from a mounting space,
the space including a dashboard with a rim (the rim inherent),
the space including a viewing opening for a speedometer,
the speedometer located at the rear of a window,
and the original part not possessing instrument mounts (i.e., OEM),
installing a replacement part having at least one instrument mount, the mount located on a front side of a window,
locating the additional instrument(s) before, or after, installation of the replacement part (inherent, and dependent on type of instrument).

(NOTE: It is clear that this method is obvious from viewing the bezel, or any replacement part - removing an original part, and installing a new replacement part, are obvious, if not intuitive, steps.)

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(11) Response to Arguments

Appellant's sole issue for Appeals involves the legality of the prior art. Arguments are provided at great length towards this issue.

Examiner maintains that the flyer provided by Auto Meter Products is proper prior art, and was submitted in good faith, in response to a proper query by the Examiner. All other associated concerns of the Applicant; e.g., "[no] evidence that [the flyer] was received by at least one member of the public" (p 9, first paragraph), or "Auto Meter has a significant pecuniary interest in scuttling a third party's attempt to secure patent protection" (p 9, last paragraph), are groundless.

It is clear that the flyer was clearly intended, and utilized, as part of a mass mailing to their customers since it promoted its booth at the SEMA Convention in 1999 (as indicated at the bottom of the flyer).

Appellant continues in this vein by arguing that Examiner's queries to Auto Meter was "improper", and "violates" 37 CFR 1.105 and "Rule 56" (pp 12-13). First, Examiner notes that 37 CFR 1.105(a)(1)9i)-(vii) (or MPEP 704.11(a)) "lists specific examples of information that may be reasonably required...for examination of an application...". This list includes

"(E) The trade names and providers of any goods or services in competition with the goods or services the claimed subject matter has been embodied in."

Appellant, in fact, properly submitted Auto Meter as such a "provider" in a previous IDS; i.e., Appellant introduced this source of information to the Office. Examiner merely, and reasonably, *continued a proper search for prior art* by contacting this firm for additional information. She requested any additional information that was available to the public, that involved any product (bezel) similar to that featured in the catalog provided by the Appellant prior to June 1999. This request for information was entirely proper within the scope of 37 CFR 1.105.

Second, Rule 56 is totally irrelevant because this application is (still) in prosecution, and NOT a trial (p 12, "discovery of material information").

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Lastly, on pp 14-16, Appellant opines at great length with respect to "[t]he prosecution history of U.S. Patent no. D480,341 [as] contradict[ing the] existence of the [flyer provided by Auto Meter]". The prosecution history with respect to U.S. Patent no. D480,341 is clearly irrelevant to the prosecution of the present application. Thus, this line of argument is moot.

12) Conclusion

For the above reasons, it is believed that the rejections should be sustained.


Conferees: L. Morris, P. English, L. Lum.

LDM PEE

Respectfully submitted,

Ms. Lee S. Lum
Examiner
July 22, 2004




LESLEY D. MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600